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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

DICUS, TAMRA

ART UNIT

PAPER NUMBER

1774

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/030,824

Applicant(s)

WEBER, KLAUS

Examiner

Tamra L. Dicus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-10, are drawn to a transfer foil.

Group II, claim(s) 11 drawn to a process for producing a transfer foil.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the special technical feature is taught by WO 95/26872. During a telephone conversation with Kevin McDermott on 1/16/03 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-10. Affirmation of this election must be made by applicant in replying to this Office action. Claim 11 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

1. Claim 2 is objected to because of the following informalities: Claim 2 is objected to. "can be pulled off same" makes no sense. Appropriate correction is required.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear which "said surface" this phrase refers to. The phrase "the one/other surface" lacks antecedent basis.
3. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear if a release layer is present. The phrase "region-wise manner" is indefinite. The phrase, "Possibly a second ..adhesive..between..." does not make sense. Further, it is unclear as to if a second heat-activatable adhesive layer is present.
4. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear if a release layer is present. The phrase "region-wise manner" is indefinite. In claim 4, the phrase, "for example" is indefinite.
5. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear if a release layer is present. The phrase "region-wise manner" is indefinite. In claim 7, it is unclear as to what the phrase "a material which is of a similar effect in terms of refraction" is referring to. Applicant provides no definition of "similar".

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 3922435 to Asnes in view of USPN 5,962,110 to Penke-Wevelhoff in view of USPN 5,925,431 to Schoenfelder.

Asnes teaches a dry-release heat transfer label for objects such as plastic bottles. The label is formed by a resinous release layer on a suitable temporary carrier (carrier foil), with a transfer layer, including a design print on the release layer and a heat -activatable adhesive layer upon the transfer layer. Asnes explains the composition of the release layer and the transfer layer are such that at heat transfer temperatures, the relative strengths of the bonds between them and their cohesiveness, permit the release layer, with its temporary carrier, to be stripped from the transfer layer which remains adhered to the object without leaving any substantial amount of the transfer layer with the release layer. The transfer layer is preferably formed by a clear lacquer (representing "transparent replication lacquer of claim 10) printed on the release layer with a design print in registry with it and a clear adhesive layer (meeting limitations "can be printed on" of claim 4). The clear lacquer and adhesive layers desirably contain a fluorescent dye for accurate registration during printing using ultraviolet light, meeting limitations of claim 9. Furthermore, regarding claims 4 and 10, that the transfer foil is able to be

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printed upon by a printer is not germane since it has been held that an element that is “being able to” perform a function (can be) is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138. Also, “a layer which covers the structure at least in a region-wise manner...of high refractive index...” of claim 10 is disclosed by the reference.

Asnes is silent to a base foil/paper being siliconised. Penke-Wevelhoff teaches a transfer image comprising a cover paper or foil that is silicone- coated (siliconised foil) and coated with a transfer lacquer and adherent-melt adhesive (heat-activatable adhesive) which is applied to substrates such as glass wood or human skin. See to col. 2, lines 1-30. Hence it would have been obvious to one of ordinary skill in the art to modify the heat transfer label of Asnes to include a siliconised foil since Penke-Wevelhoff teaches it is conventional to use in transfer media at col. 2, lines 14-30 for releasing properties.

Asnes is silent to teaching a transfer label subdivided into plurality of individual elements as recited in claim 2. Schoenfelder teaches a label with integrated coding that is subdivided into a plurality of individual elements as shown in Figures 3a-7, see also col. 6, lines 34-40, and col. 7, lines 32-50. Hence it would have been obvious to one of ordinary skill in the art to modify the label of Asnes to provide separate subdivided elements in order to dispense individual transfers as taught by Schoenfelder at col. 7, lines 31-55.

While Asnes is further silent to stamping individual elements, that such elements are formed by stamping.... (claim 3) is a process limitation in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce

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it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 29 531. Moreover, Schoenfelder teaches it is known to hot-stamp labels at col. 8, lines 55-63.

Asnes is silent to teaching an optical/holographic action and a vapor deposited layer of ZnS, TiO₂, SiO (claims 5-7). However, Schoenfelder teaches where a titania is provided on a paper foil for the purpose of providing conductivity to a film for protection at col. 10, lines 55-65. Since the same materials are used, the optical/holographic action and its refractive index comparison are inherent properties. Hence it would have been obvious to one of ordinary skill in the art to modify the label of Asnes to further include a vapor deposited titania layer for the purpose of protecting the label against oxidation as taught by Schoenfelder, col. 10, lines 55-65.

Regarding claim 8, that the substrate "is formed by two adhesive portions..." is a process limitation in a product claim. Process limitations add no patentable weight in a product claim. See MPEP 2113.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- USPN 5,731,898 to Orzi et al. teaches SiO vapor deposited film for decals.
- USPN 5,575,507 to Yamauchi et al. teaches a heat transfer media with a hologram sheet using fluroesent brighteners.

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- USPN 4,399,178 to Barta teaches decals with individual elements performed by hot-stamping for printing purposes.
- USPN 3,900,643 to Kluge et al. teaches a decal with removable lacquer coating around the edges of the decoration.
- USPN 4,294,641 to Reed et al. teaches heat transfer sheets with a clear transparent transfer layer.
- USPN 4,328,276 to Swarovski teaches its known to apply reflective plastic films.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is (703) 305-3809. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-8329 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Tamra L. Dicus
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

March 4, 2003

